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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,354	08/14/2006	Roberto Casonati	102792-600 (11374P6 US)	9816
27389 7590 09/02/2009 NORRIS, MCLAUGHLIN & MARCUS 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			EXAMINER NGUYEN, HAIDUNG D	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 09/02/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,354	Applicant(s) CASONATI, ROBERTO	
	Examiner Haidung D. Nguyen	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/1/09 has been entered.
2. Claims 1-19 are currently pending.
3. Claims 1 and 3-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fry et al. (5,360,567). This rejection is withdrawn in view of applicant's amendment.
4. Claims 1-7 and 14-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Holderbaum et al (WO00/04122). This rejection is maintained. The newly claimed limitation "wherein the at least one water-softening active comprises sodium citrate and is present in an amount of at least 42% by weight of the composition" is taught by Holderbaum et al (trisodium citrate, col 4 - ln 37 and col 4, ln 27-37).
5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holderbaum et al (WO00/04122) in view of Fry et al. (5,360,567). This rejection is maintained. The newly claimed limitation "wherein the at least one water-softening active comprises sodium citrate and is present in an amount of at least 42% by weight

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of the composition" is taught by Holderbaum et al (trisodium citrate, col 4 - ln 37 and col 4, ln 27-37).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 is amended to add new limitation "wherein the at least one water-softening active comprises sodium citrate and is present in an amount of at least 42% by weight of the composition" was not disclosed in the specification at the time the application was filed, therefore it is new matter. While the applicant's specification paragraphs 006, 0014, 0015 and 0047 discloses the crystalline materials is present in an amount of more than 42% by weight and the example shows citrate at 60.5% and 46% by weight, there is no disclosure of sodium citrate as being present in an amount of more than 42% by weight. Thus, this newly added limitation is new matter.

Response to Arguments

7. Applicant's arguments filed 7/1/09 have been fully considered.

Applicant firstly asserts that the newly added limitation is not new matter. As discussed above, since applicant does not disclose sodium citrate being present in an amount of more than 42% by weight, thus this newly added limitation is new matter.

Regarding the rejection of claims 1 and 3-16 over Fry et al (5,360,567), this rejection is withdrawn in view of applicant's amendment.

Regarding the rejection of claims 1-7 and 14-19 over Holderbaum et al (WO00/04122), Applicant asserts that Holderbaum fails to teach or suggest a compressed water-softening composition comprising least one water-softening active comprises sodium citrate and is present in an amount of more than 42% by weight of the composition, a cross linked polyplasdone; a water swellable cellulose and, optionally, a water soluble salt, wherein the compressed water-softening composition has hardness of at least 175N. However, as also stated in the previous actions, Holderbaum discloses a compressed water-softening composition comprising least one water-softening active comprising sodium citrate (trisodium citrate, col 4, ln 37) in quantities of 10 to 90% by weight of the tablet (col 4, ln 27-37), a cross-linked polyplasdone (polyvinylpyrrolidone - column 8, line 59), a water swellable cellulose (carboxymethyl cellulose - column 9, line 19), and water soluble salt (trisodium citrate solubility in water of 72 g/100 ml- column 4, line 37). Although Holderbaum fails to teach or suggest the composition having hardness of at least 175N. However, since Holderbaum discloses identical or substantially identical composition that set forth by applicant; thus, the tablet of Holderbaum would possess the same hardness as claimed. "Where the claimed and prior art products are identical or substantially identical in

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structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established." *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

"When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Regarding rejection of Claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over Holderbaum et al (WO00/04122) in view of Fry et al., Applicant again asserts that Holderbaum in combination of Fry fail to teach or suggest a compressed water-softening composition comprising least one water-softening active comprises sodium citrate and is present in an amount of more than 42% by weight of the composition and the composition has hardness of at least 175N. However as discussed above, Holderbaum discloses a compressed water-softening composition comprising least one water-softening active comprising sodium citrate (trisodium citrate, col 4, ln 37) in quantities of 10 to 90% by weight of the tablet (col 4, ln 27-37). Although, neither Holderbaum nor Fry teach or suggest the composition having hardness of at least 175N; However, since Holderbaum discloses identical or substantially identical composition

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that set forth by applicant; thus, the tablet of Holderbaum would possess the same hardness as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haidung D. Nguyen whose telephone number is (571)270-5455. The examiner can normally be reached on M-Th: 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harold Y Pyon/
Supervisory Patent Examiner, Art
Unit 1796

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Examiner – AU 1796